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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,839	03/14/2001	Isabelle Jouve	022701-907	5002

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EXAMINER

KILLOS, PAUL J

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 06/19/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.



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DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 18 Mar 2002 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire Three month(s), days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☐ Claims 2-27 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☐ Claims 2-27 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

This is in response to the communication filed 18 March 2002.

The claims are 2-27. Claims 27, 2-6, 13-16, 18-23 are rejected under 35 U.S.C. 103 as being unpatentable over Hoefnagel wo/94/14746. Example 3 of the reference renders obvious if not clearly anticipated the subject matter of the claims 27, 2-6, 13-16, 18-23. The reference teaches using zinc oxalate in catalytic amounts.

When one considers to molar ratio, it's well within that shown on page 12 of the instant specification. As a note of interest, oxalic acid is a poly carboxylic acid. Why does applicant argue that position of the Examiner that oxalic acid per se can be generated from glyoxylic acid by the Connigeros reaction when claim 21 is directed precisely to that process.

Claims 27, 2-16, 13, 15-24 are rejected under 35 U.S.C. 103 as being obvious over U.S. Pat 4,339,602 to Schouteeten. Example 1 of the reference is directed to a process for making 4-hydroxy 3-methoxy-mandelic acids by reacting gaiacol, 2-methoxy phenols, and glyoxylic acid in a basic aqueous medium. And, while the reference does not recite poly carboxylic acid, it is well established, and applicant acknowledge in claim 21, and the reference on column 1, lines 21-23 that oxalic acid in a basic aqueous solution. Applicant's argument that the Examiner needs to show that the production of oxalic acid in situ is not considered cogent. Applicants clearly attest to that reaction in their own specification and claims.

Claims 25 ^{is} ~~are~~ rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 25 ~~are~~^{is} provides for the use of ~~p~~^p-hydroxy mandelic, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 25 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25 ~~are~~^{is} rejected under 35 U.S.C. 103(a) as being unpatentable over wo/9414746 as applied to claim 25 and 26 ~~are~~^{as} above, and further in view of U.S. Pat 4165,341 to Umemuro

The primary reference has been discussed above as it relates to making p-hydroxyl mandelic acid. The secondary reference, Example II, is directed to ~~oxidation~~^{oxidation} of the reaction product of the first reaction to yield benzaldehyde. It would then be obvious to one ~~so~~^{of} the ordinary skill in the to carry out the reaction of the primary reference followed by the reaction of the secondary reference.

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Especially since the secondary reference teaches the reaction of the primary reference of but fails to isolate the product (intermediates) and proceeds to oxidize the p-hydroxyl mandelic acid to the benzaldehyde derivative.

Claims 7-12 are again rejected under 35 U.S.C. 103 as being unpatentable over wo 94/14736 when considered with Chem. Abst 117:191094. The primary reference has been discussed above as it applies to claim 27. The secondary reference is used here for the teaching that aliphatic dicarboxylic acids display higher degree of catalytic activity in acylation reaction

Any inquiry concerning this communication should be directed to Paul J Killos at telephone number 308-0135.

Killos/dl

June 17, 2002.


PAUL J. KILLOS
PRIMARY EXAMINER
gf/600